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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/069,403

02/26/2002

Timo Haataja

P 290634

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11/13/2007

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EXAMINER

POINVIL, FRANTZY

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

11/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/069,403

Applicant(s)

HAATAJA ET AL.

Examiner

Frantzy Poinvil

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 8/21/2007 have been fully considered but they are not persuasive.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9-11, 18-20 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil (US Patent No. 6,226,364).

As per claims 1, 9, 18-20 and 24, O'Neil discloses a system and method for providing prepaid and credit-limited telephone services. The system and method comprise:

Maintaining subscriber information on at least one subscriber (this is similar to the user profile of O'Neil);

Defining at least two different tariff models (local and long distance and international rates and roaming rates), each model containing a tariff scheme defining how to charge a call;

Indicating in the subscriber information directly or indirectly which tariff model is to be used with this subscriber (based on the calling or dialed number); and

Charging the subscriber according to the tariff scheme of the indicated tariff model. See column 14, lines 1-12 of O'Neil.

Applicant's representative argues that O'Neil does not teach or suggest maintaining information on at least one subscriber of a telecommunication network. In response, the Examiner disagrees as O'Neil teaches maintaining a user's account and a database profile.

Applicant's representative also argues that O' maintaining at least two different tariff models, each model containing a tariff scheme defining how to charge a call.

In response, O'Neil discloses a customer can be a subscriber or a roamer, thus having two different tariff models, each model containing a tariff scheme defining how to charge a call. Furthermore, if a call is a local call or an international call or if a call is made during off-peak hours or peak hours, different charges would apply. Thus, indicating in the subscriber information directly or indirectly which tariff model is to be used with a subscriber is taught by O'Neil because a subscriber may be regular subscriber, or a roamer subscriber placing local or international calls at different times of the day wherein each call made by a type of subscriber and/or time of the day and place of calling to/from is charged a different rate or tariff.

As per the claimed limitations of "detecting that the subscriber is making a call". The Examiner asserts that such is the responsibility of the service provider to enabling proper telecommunications, charging and billing.

Thus, O'Neil teaches all the claimed limitations.

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Applicant then argues that the customer service profile of O'Neil does not maintain any subscriber information on at least one subscriber. In response, if it is the case, then why is there a subscriber database or a subscriber profile database. A customer or subscriber database is to store information about a subscriber. Applicant is also referred to column 15, lines 39-52, column 18, lines 59-67 and column 16, lines 2-20 of O'Neil.

Applicant then argues that O'Neil only discloses or mentions prepaid and postpaid rating parameters and does not disclose local, long distance, international or roaming rates.

In response, a telephone service provider usually provides or facilitates their clients to make local, long distance, international calls and roaming rates or service. otherwise, all calls would be charged the same and there would not be any regulations or distinctions as to the types of calls being placed, charged or billed.

Applicant then argues that O'Neil fails to teach or suggest calculating a charge for the call according to the tariff scheme of the indicated tariff model.

In response, in the system of O'Neil as in most telephone systems, service providers usually calculate charges based on the tariff associated with the time of day, number of hours and number of minutes spent. Calculating a charge for a call based on a tariff scheme is taught by O'Neil as O'Neil deals with regular calls and roaming calls. See also column 23, lines 29-43 and column 21, lines 51-69 of O'Neil.

As per claims 2 and 10, O'Neil discloses defining one tariff (the local rate) to be a default model which is used when no other tariff model is indicated. See column 11, lines 48-65, column 10, lines 9-23 and column 15, lines 39-52 of O'Neil.

As per claims 3 and 11, O'Neil discloses the telecommunications network offers a prepaid service to its subscribers and the at least one subscriber is a prepaid subscriber. See the abstract.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8, 12-17 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil (US Patent 6,226,364).

As per claims 4, 7 and 14, the teachings of O'Neil are discussed above. O'Neil discloses a prepaid card system and method using at least two different types of vouchers or payment systems such as a credit card or debit card for making deposits into subscribers prepaid accounts (column 4, lines 57-65). O'Neil does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis of the voucher this subscriber is currently using. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls

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by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Charging or billing one tariff model to a type of voucher would have been left to the owners of the system of O'Neil since doing so would have been left as an agreement between the owners and the users or clients of the system of O'Neil. The motivation to introduce such a billing scheme in the system and method of O'Neil would have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

As per claims 5 and 6, 12, in depositing funds from a voucher or billing card, the user's subscriber information must be checked and if the voucher or billing card is an allowed one (based on sufficient funds or based on correct Id, PIN or password), then continuing depositing and if the voucher is not an allowed one, terminating depositing (column 19, line 48 to column 20, line 2 and column 22, lines 11-63).

As per claims 9 and 13 and 15-17, O'Neil discloses a system and method for providing prepaid and credit-limited telephone services. The system and method comprise:

Maintaining subscriber information on at least one subscriber (this is similar to the user profile of O'Neil). O'Neil discloses using at least two different types of vouchers or payment systems such as a credit card or debit card for making deposits into subscribers prepaid accounts (column 4, lines 57-65). O'Neil does not explicitly state attaching one tariff model at least to each of the two different types of vouchers or indicating in the subscriber information the type of voucher this subscriber is currently using and determining the tariff model to be used on the basis

of the voucher this subscriber is currently using. However, it is well known in the art at the time of the invention that "A prepaid service is a service where a subscriber pays in advance his calls by buying vouchers. The prepaid service logic and prepaid service data are stored in the system...the prepaid service enables roaming subscribers to pay their local calls at local tariffs, whereas the use of the SIM card of their home service provider results in paying international tariffs to their home network and back". Charging or billing one tariff model to a type of voucher would have been left to the owners of the system of O'Neil since doing so would have been left as an agreement between the owners and the users or clients of the system of O'Neil. The motivation to introduce such a billing scheme in the system and method of O'Neil would have been to redistribute types of charges to a credit card or a billing card in case one of the client's billing card become exhausted.

The system and method finding out which of the defined tariff models to be used with a subscriber from the subscriber information in defining how to charge a call would have been obvious to one of ordinary skill in the art to do especially in the case one of the subscriber's vouchers become exhausted thus, allowing alternate means or form of payment to enable a call transaction or in the case roaming charges need to be assessed.

Applicant's representative then argues that the background section fails to teach or suggest the use of voucher type and that the Examiner is engaged in hindsight reconstruction of the claimed invention.

In response, a subscriber usually uses vouchers to make phone calls using a particular service provider communication system. O'Neil teaches storing customer's



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profiles, providing different types of services such as local calls, long distance calls and roaming calls.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

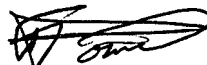
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**Frantzy Poinvil  
Primary Examiner  
Art Unit 3692**

FP  
October 22, 2007